



UNITED STATES PATENT AND TRADEMARK OFFICE

A

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/011,857	11/05/2001	Debendra Das Sharma	10017812 - 1	5264

7590 07/21/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

DANG, KHANH

ART UNIT	PAPER NUMBER
----------	--------------

2111

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/011,857

Applicant(s)

SHARMA, DEBENDRA DAS

Examiner

Khanh Dang

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 14, the amended terms "first set of electronic devices" and "second set of electronic devices" lack clear antecedent basis. It is unclear whether there are sets of "electronic devices" in addition to the first and second electronic devices, since the preamble only specifies a communication method between a first and second electronic devices.

In claim 9, the word "directly" is unclear. It appears that the first and second electronic devices are connected via an "electronic communications medium."

In claim 11, the essential structural cooperative relationship(s) between the "number of electronic communication media" and the forwarding node have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. Further, it is unclear what may be a "number of electronic communication media."

In claim 13, it is unclear what may be "an electronic device." There are only first and second devices recited in claim 1.

In claim 15, the essential structural cooperative relationship(s) between the "first electronic device" and "the second electronic device" have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP

Art Unit: 2111

§ 2172.01. Further, the term "set electronic devices" (page 28, line 4) lacks clear antecedent basis. It is unclear whether there is another set "electronic devices" in addition to the first and second electronic devices.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Uchara et al. (Uchara).

At the outset, it is noted that similar claims will be grouped together to avoid repetition.

As broadly drafted, these claims do not define any structure/step that differs from Uchara.

With regard to claim 15, Uchara discloses a system containing two intercommunicating electronic devices (1a and 2a) comprising: a first electronic device or source/producing node (2a) that stores new and pending requests in an electronic

Art Unit: 2111

memory (200) and retrieves new and pending requests from the electronic memory for transmission; a retry bit (stored in flag register 120/retry register) associated with each stored request within the first electronic device (2a); a second electronic device or destination/consuming node (1a) that accepts requests transmitted from the first electronic device (2a), transmitting back to the first electronic device an ACK reply (acknowledgement/OK), and rejects requests transmitted from the first electronic device, transmitting back to the first electronic device a NAK reply (retry); and a retry vector (see Figs 2-4 and description thereof, particularly Header Flag and Transaction ID. 4-8, 12-14) maintained by the second electronic device containing bits corresponding to electronic devices from which the second electronic device receives requests that need to retransmit one or more rejected requests. With regard to claims 1, 5-8, it is clear that one using the apparatus of Uchara would have performed the same step set forth in claims 1, 5-8. With regard to claim 4, it is clear that node (2a) stores new and pending request in input queue in (200). With regard to claim 9, as best the Examiner can ascertain from the language of the claim, it is clear that node (1a) and node (2a) are connected by node (3). With regard to claims 10 and 11, the interfaces between the network 3 and node 1(a) and node 2(a) are readable as first communications medium and second communication medium; the network node (3) is readable as a forwarding node. With regard to claim 12, it is clear that node 1(a) and node (2a) are bus-connected. With regard to claims 13 and 14, see Figs. 2-4, and description thereof regarding retry vector, particularly Header Flag and Transaction ID.

Response to Arguments

Applicants' arguments filed 8/10/2004 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

The 112 Rejection:

In response to Applicants regarding claim 1, the amended terms "first set of electronic devices" and "second set of electronic devices" lack clear antecedent basis. It is unclear whether there are sets of "electronic devices" in addition to the first and

Art Unit: 2111

second electronic devices, since the preamble only specifies a communication method between a first and second electronic devices.

In claim 9, the word "directly" is unclear. It appears that the first and second electronic devices are connected via an "electronic communications medium." In other words, when there is an communications medium between the devices, they are not directly connected.

In claim 11, the essential structural cooperative relationship(s) between the "number of electronic communication media" and the forwarding node have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The claim is directed to an apparatus, and therefore, structural cooperative relationships between elements recited in the claims must be set forth according to MPEP 2172.01. MPEP 2172.01 clearly states that "a claim which fails to interrelate (emphasis added) essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). It is clear that various recited elements function simultaneously, are directly functionally related, directly intercooperate, and/or serve independent purposes. It is suggested that with support from the originally filed specification, the word "connected" may be used to provide structural relationships between elements.

Art Unit: 2111

In claim 13, it is unclear what may be "an electronic device." There are only first and second devices recited in claim 1; and the relationship(s) between the "electronic device" and first and second devices have not been clearly set forth.

In claim 15, the essential structural cooperative relationship(s) between the "first electronic device" and "the second electronic device" have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The claim is directed to an apparatus, and therefore, structural cooperative relationships between elements recited in the claims must be set forth according to MPEP 2172.01. MPEP 2172.01 clearly states that "a claim which fails to interrelate (emphasis added) essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). It is clear that various recited elements function simultaneously, are directly functionally related, directly intercooperate, and/or serve independent purposes. It is suggested that with support from the originally filed specification, the word "connected" may be used to provide structural relationships between elements. Further, the term "set electronic devices" (page 28, line 4) lacks clear antecedent basis. It is unclear whether there is another set "electronic devices" in addition to the first and second electronic devices.

The 102 Rejection:

With regard to the Examiner's U.S.C. 102(e) rejection, Applicants submit a "Rule 131 Affidavit in which Applicant attests to submitting a disclosure of the current invention on June 11, 2001, prior to the July 3, 2001 filing date of Uchara. The Rule 131 Affidavit is supported by a dated disclosure document. In view of the Rule 131 Affidavit and supporting materials, Uchara is not citable under U.S.C. 102(e)."

In response to Applicants' argument, the declaration under 37 CFR 1.131 filed 8/10/2004 is insufficient to overcome the rejection of claims 1, 4-15 over Uchara under 35 USC § 102(e) as set forth in the last Office action because it is not properly executed and fails to establish reduction to practice prior to the date of the reference.

Applicants attempt to establish prior invention by showing filing date of the invention prior to the filing date of Uchara (7/3/2001). In the affidavit Applicants state that the invention was reduced practice. However, a written description does not constitute an actual reduction to practice. Furthermore, only the filing of a US patent application which complies with the disclosure requirement of 35 USC § 112 constitutes a constructive reduction to practice. A written description, no matter how complete, which has not been made the subject of a US patent application does not qualify as reduction to practice. In any event, it is Applicants' acknowledgement that the invention is not built or tested (see Exhibit 1).

Accordingly, applicant has not established prior invention. The rejection is maintained.

Allowable Subject Matter

Claims 2, 3, 16-20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.

Khanh Dang

Khanh Dang
Primary Examiner